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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,903	07/16/2003	Joseph L. Tallal JR.	GM2:1004	8952
34725 7590 07/31/2007 CHALKER FLORES, LLP 2711 LBJ FRWY Suite 1036 DALLAS, TX 75234			EXAMINER RAPILLO, KRISTINE K	
			ART UNIT 3609	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/620,903		TALLAL, JOSEPH L.	
	Examiner		Art Unit	
	Kristine K. Rapillo		3609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/23/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1 – 27 are pending.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1 - 110 (Copay), Figure 2B – 256 (Copay/Deductible), and Figure 11C – 1180 (Insurance company pays provider for good or services provided above deductible). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 4 – 318 (Premium listings) and Figure 9C – 804 (Pharmacy benefit manager). The examiner interprets the reference number 318 in Figure 4 to be a typographical error; reference number 308 refers to 'premium listing' in the specification for Figure 4.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because the reference characters listed below have been used to designate the same description in the specification
 - 672 and 1172 – Contact select provider
 - 110 and 256 – Copay

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- 212, 712, 812, and 1008 – Discount price
- 104 and 202 – Individuals
- 102, 252, and 1002 – Insurance company
- 634 and 1132 – Join member provider network
- 258 and 1010 – Major medical payment
- 208 and 1012 – Medical service/good provider listing and discount price list
- 206, 302, 418, 420, 422, 424, and 426 – Medical service/good providers
- 202, 402, 408, 410, 412, 414, and 416 – Members
- 504, 710, 810, and 1006 – Network provider
- 664, 962, and 1162 – Pay membership fee to join member-provider network
- 644, 936, and 1142 – Pay premium listing fee
- 108 and 254 – Premium
- 308 and 932 – Premium listing
- 642 and 1140 – Provide basic listing information
- 614, 908, and 1120 – Provide basic/premium listings and price lists to members
- 648 and 1146 – Provide goods or services to members
- 938 and 1144 – Provide premium listing information
- 610 and 1110 – Receive advertising fees
- 674 and 1174 – Receive goods or services from provider
- 604, 902, and 1116 – Receive membership fees from new and renewing members
- 650 and 1150 – Receive payment for goods or services

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- 666 and 1166 – Search provider list by area
- 668 and 1168 – Select provider and review provider listing
- 638 and 1136 – Submit price list
- 618, 916, and 1124 – Update information provided to members

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character 202 has been used to designate both Individuals and Members.

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

6. Claims 24 and 25 are objected to because of the following informalities: Claims 24 and 25 reference claim 25. Appropriate correction is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 – 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 7, 11 – 12, 21 – 23, and 26 – 28 of copending Application No. 10/620,904 (Tallal). This is a provisional obviousness-type double patenting rejection. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations from the claims of U.S. Application No. 10/620,903 are covered in the claims of U.S. Application No. 10/620,904.

9. The table below is a comparison of all obvious-type double patenting claims. The differences between the claims have been bolded and a summary of the rejection is included in the row directly below the affected claims.

Application 10/620,903	Reference: Application 10/620,904
<p>1. A system comprising:</p> <p>a pharmacy benefit manager that provides a pharmaceutical benefit program;</p> <p>one or more individuals that are members of the pharmaceutical benefit program;</p> <p>and a discount price list provided by the pharmacy benefit manager that regulates the cost of pharmaceuticals provided to the members by the pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided based on the discount price list.</p>	<p>1. A system comprising:</p> <p>a network provider that provides a health care plan;</p> <p>one or more medical service/good providers that have joined the health care plan;</p> <p>one or more individuals that are members of the health care plan;</p> <p>and a discount price list provided by the network provider that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any</p>

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	services/goods rendered based on the discount price list.
<p>Regarding claim 1:</p> <ul style="list-style-type: none"> • A pharmacy benefit manager is providing the same function as a network provider. Each function assumes the responsibility to oversee a health care plan (including pharmaceuticals). • A pharmaceutical benefit program is an off-shoot of a health care plan – a health care plan provides for medical services, whereas a pharmaceutical benefit program provides for prescription drug medication (which are generated from a medical service visit). • The term pharmaceuticals is encompassed by the generic term of services/goods, in that pharmaceuticals can be 'services/goods'. <p>Therefore, claim 1 of this application is not patentably distinct from application 10/620,904.</p>	
2. The system as recited in claim 1, wherein the discount price list is a variable discount price list that tracks a known standard pharmaceutical price list.	2. The system as recited in claim 1, wherein the discount price list is a variable discount price list that tracks a known standard service price list.
Regarding claim 2, the standard pharmaceutical price list and the standard service price list serve the same function in that they both track a standard price list, therefore, claim 2 of this is not patentably distinct from claim 2 of the reference application.	
3. The system as recited in claim 1, wherein the individuals pay a membership fee to the pharmacy benefit manager to join the pharmaceutical benefit program .	3. The system as recited in claim 1, wherein the individuals pay a membership fee to the network provider to join the health care plan .
Regarding claim 3, a pharmacy benefit manager is providing the same function as a network provider. Each function assumes the responsibility to oversee a health care plan (including pharmaceuticals), in which the pharmacy benefit manager and network provider are the recipients of the membership fees used join the pharmaceutical benefit program or health care plan. Therefore, claim 3 of this application is not patentably distinct from claim 3 of the reference application.	
4. The system as recited in claim 3, wherein the membership fee is paid by the individual's employer.	4. The system as recited in claim 3, wherein the membership fee is paid by the individual's employer.
Regarding claim 4: Claim 4 is not patentably distinct from claim 4 of the reference application, therefore, claim 4 is obvious.	
5. The system as recited in claim 3, wherein the membership fee is paid by the individual's business.	5. The system as recited in claim 3, wherein the membership fee is paid by the individual's business.

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Regarding claim 5: Claim 5 is not patentably distinct from claim 5 of the reference application, therefore, claim 5 is obvious.	
6. The system as recited in claim 3, wherein the membership fee is a renewal fee.	6. The system as recited in claim 3, wherein the membership fee is a renewal fee.
Regarding claim 6: Claim 6 is not patentably distinct from claim 6 of the reference application, therefore, claim 6 is obvious.	
7. The system as recited in claim 1, wherein the member includes his/her family in the pharmaceutical benefit program .	7. The system as recited in claim 1, wherein the member includes his/her family in the health care plan .
Regarding claim 7, a pharmaceutical benefit program is an off-shoot of a health care plan – a health care plan provides for medical services, whereas a pharmaceutical benefit program provides for prescription drug medication (which are generated from a medical service visit). Therefore, claim 7 is obvious.	
8. The system as recited in claim 1, further comprising a pharmaceutical listing provided by the pharmacy benefit manager to the members.	10. The system as recited in claim 1, further comprising a medical service/good provider listing provided by the network provider to the members.
Regarding claim 8: <ul style="list-style-type: none"> • A pharmacy benefit manager is providing the same function as a network provider. Each function assumes the responsibility to oversee a health care plan (including pharmaceuticals) • A pharmaceutical listing is equivalent to a medical service/good provider listing in that each are a listing of all medications and physicians within a health care plan. • Therefore, claim 8 is obvious 	
9. The system as recited in claim 8, wherein the pharmaceutical listing comprises basic listings and premium listings.	11. The system as recited in claim 10, wherein the medical service/good provider listing comprises basic listings and premium listings.
Regarding claim 9: Claim 9 is not patentably distinct from claim 11 of the reference application, therefore, claim 9 is obvious.	

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10. The system as recited in claim 9, wherein the basic listings are provided to pharmaceutical companies free of charge.	12. The system as recited in claim 11, wherein the basic listings are provided to medical service/good providers free of charge.
Regarding claim 10: Claim 10 is not patentably distinct from claim 12 of the reference application, therefore, claim 10 is obvious.	
11. The system as recited in claim 9, wherein the premium listings are provided to pharmaceutical companies upon payment of a premium listing fee.	13. The system as recited in,claim 11, wherein the premium listings are provided to medical service/good providers upon payment of a premium listing fee.
Regarding claim 11: Claim 11 is not patentably distinct from claim 13 of the reference application, therefore, claim 11 is obvious.	
12. The system as recited in claim 9, wherein the premium listings include a link to a customizable web page for the pharmaceutical company that is accessible via a global telecommunications network.	14. The system as recited in claim 13, wherein the premium listings include a link to a customizable web page for the medical service/good providers that is accessible via a global telecommunications network.
Regarding claim 12: Claim 12 is not patentably distinct from claim 14 of the reference application. Claim 12 refers to a web page for a pharmaceutical company whereas, claim 14 of the reference application refers to a web page for a medical service/good provider. The same system can be used for the pharmaceutical company and medical service/good provider, therefore, claim 12 is obvious.	
13. The system as recited in claim 9, wherein the premium listings include a link to the pharmaceutical company's web site.	15. The system as recited in claim 13, wherein the premium listings include a link to the medical service/good provider's web site.
Regarding claim 13: Claim 13 is not patentably distinct from claim 15 of the reference application, therefore, claim 13 is obvious.	
14. The system as recited in claim 9, wherein the premium listings are customized for each pharmaceutical company.	16. The system as recited in claim 13, wherein the premium listings are customized for each medical service/good provider.

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Regarding claim 14: Claim 14 is not patentably distinct from claim 16 of the reference application, therefore, claim 14 is obvious.	
15. The system as recited in claim 8, wherein the discount price list and the pharmaceutical listing is accessible via a global telecommunications network.	17. The system as recited in claim 10, wherein the discount price list and the medical service/good provider listing is accessible via a global telecommunications network.
Regarding claim 15: Claim 15 is not patentably distinct from claim 17 of the reference application, therefore, claim 15 is obvious.	
16. The system as recited in claim 8, wherein the discount price list and the pharmaceutical listing are searchable by the members using one or more search criteria.	18. The system as recited in claim 10, wherein the discount price list and the medical service/good provider listing are searchable by the members using one or more search criteria.
Regarding claim 16: Claim 16 is not patentably distinct from claim 18 of the reference application, therefore, claim 16 is obvious.	
17. The system as recited in claim 1, further comprising one or more advertisements provided by the pharmacy benefit manager to the members.	21. The system as recited in claim 1, further comprising one or more advertisements provided by the network provider to the members.
Regarding claim 17, a pharmacy benefit manager is providing the same function as a network provider, as per claim 1. Therefore, claim 17 of this application is not patentably distinct from claim 21 of the reference application.	
18. The system as recited in claim 17, wherein an advertiser pays the pharmacy benefit manager an advertising fee to provide the advertisements to the members.	22. The system as recited in claim 21, wherein an advertiser pays the network provider an advertising fee to provide the advertisements to the members.

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Regarding claim 18, a pharmacy benefit manager is providing the same function as a network provider, as per claim 1. Therefore, claim 18 of this application is not patentably distinct from claim 22 of the reference application.	
19. The system as recited in claim 18, wherein the advertisement provided to a member is based on one or more search criteria used to search the pharmaceutical listing.	23. The system as recited in claim 21, wherein the advertisement provided to a member is based on one or more search criteria used to search the medical service/good provider listing.
Regarding claim 19: Claim 19 is not patentably distinct from claim 23 of the reference application, therefore, claim 19 is obvious.	
<p>20. A method for providing a pharmaceutical benefit program comprising the steps of:</p> <p>receiving a membership fee from one or more individuals to become members of the pharmaceutical benefit program; and</p> <p>providing a discount price list that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided based on the discount price list.</p>	<p>26. A method for providing a health care plan comprising the steps of:</p> <p>receiving a membership fee from one or more individuals to become members of the health care plan;</p> <p>obtaining information from one or more medical service/good providers that have joined the health care plan; and</p> <p>providing a discount price list that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list.</p>
<p>Regarding claim 20:</p> <ul style="list-style-type: none"> • A pharmacy benefit manager is providing the same function as a network provider, as per claim 1. • The term pharmaceuticals is encompassed by the generic term of services/goods, as per claim 1. <p>Therefore, claim 20 of this application is not patentably distinct from claim 26 of application 10/620,904.</p>	
21. A computer program embodied on a computer readable medium for providing	27. A computer program embodied on a computer readable medium for providing

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<p>a pharmaceutical benefit program comprising:</p> <p>a code segment for receiving a membership fee from one or more individuals to become members of the pharmaceutical benefit program; and</p> <p>a code segment for providing a discount price list that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided based on the discount price list.</p>	<p>a health care plan comprising:</p> <p>a code segment for receiving a membership fee from one or more individuals to become members of the health care plan;</p> <p>a code segment for obtaining information from one or more medical service/good providers that have joined the health care plan; and</p> <p>a code segment for providing a discount price list that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list.</p>
<p>Regarding claim 21:</p> <ul style="list-style-type: none"> • A pharmacy benefit manager is providing the same function as a network provider, as per claim 1. • The term pharmaceuticals is encompassed by the generic term of services/goods, as per claim 1. <p>Therefore, claim 21 of this application is not patentably distinct from claim 27 of application 10/620,904.</p>	
<p>22. An apparatus for providing a pharmaceutical benefit program comprising:</p> <p>a server,</p> <p>one or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list that regulates cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided based on the discount price list;</p> <p>a communications interface communicably coupled to the server that allows a member to access the discount price list; and</p> <p>wherein the member is an individual that has paid a membership fee to join the pharmaceutical benefit program.</p>	<p>28. An apparatus for providing a health care plan comprising:</p> <p>a server;</p> <p>one or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list that regulates the cost of services/goods provided to a member of the health care plan by a medical service/good provider such that the member pays the medical service/good provider in-full directly for any services/goods rendered based on the discount price list;</p> <p>a communications interface communicably coupled to the server that allows a member to access the discount price list; and</p> <p>wherein the member is an individual that has paid a membership fee to join the health care plan.</p>

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Regarding claim 22: <ul style="list-style-type: none">• A pharmacy benefit manager is providing the same function as a network provider, as per claim 1.• The term pharmaceuticals is encompassed by the generic term of services/goods, as per claim 1. Therefore, claim 22 of this application is not patentably distinct from claim 28 of application 10/620,904.		

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention encompasses a human being, therefore it is directed to nonstatutory subject matter. The examiner interprets the individuals and/or members of a pharmaceutical benefit program to be human beings under the broadest reasonable interpretation of the claimed invention.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1 – 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée (<http://web.archive.org/web/20011130030647/http://carentree.com>, 2001) in view of Lipton, et al ("Pharmacy benefit management companies: Dimensions of performance", Annual Review of Public Health. Palo Alto: 1999. Vol. 20, page 361).

As per claim 1, Care Entrée teaches a pharmacy benefit manager that provides a pharmaceutical benefit program (Page 5, paragraph 22) and one or more individuals that are members of the pharmaceutical benefit program (Page 8, paragraph 38). The examiner interprets the pharmacy benefit manager to be the Care Entrée health savings plan, in that it provides a discount on all health care needs, including pharmaceuticals.

The Care Entrée program does not explicitly teach a system of providing discount price lists to members, in which the members pay the pharmacy benefit manager directly.

Lipton et al. teaches a system comprising a discount price list provided by the pharmacy benefit manager which regulates the cost of pharmaceuticals provided to the members of the program in which the members pay the pharmacy benefit manager directly for any pharmaceutical products provided (paragraph 30).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a discount price list regulating the cost of pharmaceutical products in which the member pays the pharmacy benefit manager directly as taught by Lipton et al. with the motivation of controlling prescription drug costs via negotiated discounts, formulary development, and increased use of generic

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drugs (paragraph 7). Formulary development leads to a list of preferred medications in which a pharmacy benefit manager has acquired a discounted price.

As per claim 2, the Care Entrée program fails to teaches a system as per claim 1.

Lipton et al. teaches a system in which the discount price list is a variable discount price list that tracks a known standard pharmaceutical price list (paragraph 7). This is accomplished through the use of negotiated discounts with pharmacy networks, as well as controlling the formularies used by the pharmacy benefit manager (i.e. the pharmacy benefit manager chooses which drugs to include in the formulary, thereby lowering the cost of the pharmaceuticals). It can be assumed that lists are required to provide the pharmacies and pharmacy benefit managers with the recent price list, as well as the discounted price list.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system in which a discount price list tracks a known pharmaceutical price list as taught by Lipton et al. with the motivation of managing drug costs and services (paragraphs 32 – 34). This is accomplished by a pharmacy benefit manager via drug enrollments reports/physician prescription history and rebates from the drug manufacturer. The pharmacy benefit manager takes the information and generates data pertaining to which medications are most frequently prescribed, and uses this information to negotiate a discount on that particular medication.

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As per claim 3, the Care Entrée program teaches a system in which individuals pay a membership fee to the pharmacy benefit manager to join the pharmaceutical benefit plan (Page 3, paragraph 10). The Care Entrée program discloses a method in which anyone can pay a certain fee to join a health care plan, or in this case a pharmaceutical benefit plan since a pharmaceutical benefit plan is essentially tied into a health care plan.

As per claim 4, the Care Entrée program teaches a system in which the membership fee is paid by the individual's employer (Page 12, paragraph 67).

As per claim 5, the Care Entrée program teaches a system in which the membership fee is paid by the individual's business (Page 12, paragraph 67). The examiner interprets an individual's employer, in this case, to be equivalent to an individual's business. In either case, the individual is provided the opportunity to offer employees (including self) a supplemental health care plan.

As per claim 6, the Care Entrée program teaches a system wherein the membership fee is a renewal fee (Page 2, paragraph 6). The examiner interprets the monthly fee to be a renewal fee – the member is paying a renewal fee every month.

As per claim 7, the Care Entrée program teaches a system wherein the member can include his/her family in the pharmaceutical benefit program (Page 3, paragraph

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10). The Care Entrée program allows the entire family (including all Internal Revenue Service dependents) to join the health care plan.

As per claim 8, the Care Entrée program teaches a system comprising a pharmaceutical listing provided by the pharmacy benefit manager to the members (Page 12, paragraphs 68 - 69). The Care Entrée program provides a listing of common health care providers in certain areas – a listing of pharmaceutical products can easily be substituted since the concept is similar.

As per claim 20, the Care Entrée program teaches a method for receiving a membership fee from one or more individuals to become members of the pharmaceutical benefit program (Page 3, paragraph 10). Individuals, as well as family members and/or other dependents, may pay a monthly fee in order to become a member of a supplemental health care plan.

The Care Entrée program does not teach a method to provide a discount price list regulating the cost of pharmaceuticals, and the members paying the pharmacy benefit manager directly for the pharmaceutical products.

Lipton et al. teaches a system comprising a discount price list provided by the pharmacy benefit manager, which regulates the cost of pharmaceuticals provided to the members of the program in which the members pay the pharmacy benefit manager directly for any pharmaceutical products provided (paragraph 30).

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The motivation for combining the teachings of the Care Entrée Program and Lipton et al. is discussed in claim 2.

4. Claims 9 – 19 and 21 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée (www.careentree.com) as applied to claim 1 above, in view of Lipton et al. and further in view of U.S. Patent No. 5,819,092 (Ferguson, et al.).

As per claim 9, the system of claim 8 as applied to claim 1, is taught by the Care Entrée program, in view of Lipton et al.

The Care Entrée program and Lipton et al. do not teach a system comprising basic and premium listings.

Ferguson et al. teaches a system wherein the pharmaceutical listing comprises basic listings and premium listings (column 7, lines 10 – 18 and column 13, lines 66 – 67 through column 14, lines 1 – 6). The examiner interprets basic and premium listings to be equivalent to a directory lookup service, as disclosed in Ferguson et al. The directory look up service can encompass a listing of people (i.e. physicians) and products (i.e. pharmaceuticals).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of basic and premium listings as taught by Ferguson et al. with the motivation of providing a fast method of online searching directories (column 4, lines 18 – 20 and 41 – 43).

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As per claim 10, the system of claim 9 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the basic listings are free of charge to pharmaceutical companies.

Ferguson et al. teaches a system wherein the basic listings are provided to pharmaceutical companies free of charge (column 13, lines 66 – 67 through column 14, lines 1 – 12). The examiner interprets the look up directory disclosed by Ferguson et al. to include a 'basic' listing – where a name, address and other related information is available. The related information can include prescription drug products and pharmacies participating in the pharmacy benefit plan. In addition, this information is available to users, which can encompass both pharmaceutical companies as well as members of the pharmacy benefit plan.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 9.

As per claim 11, the system of claim 9 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the premium listings are available to pharmaceutical companies for a fee.

Ferguson et al. teaches a system wherein the premium listings are provided to pharmaceutical companies upon payment of a premium listing fee (column 14, lines 6 – 12 and column 18, lines 33 - 35). The examiner interprets the look up directory

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disclosed by Ferguson et al. to include a 'premium' listing – where a name, address and a hyperlinked document with other related information is available. The related information can include prescription drug products, pharmacies participating in the pharmacy benefit plan, and pharmaceutical companies. In addition, this information is available to users, which can encompass both pharmaceutical companies as well as members of the pharmacy benefit plan.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 9.

As per claim 12,13, and 14, the system of claim 9 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the premium listings are hyperlinked to a pharmaceutical companies web page.

Ferguson et al. teaches a system wherein the premium listings include a link to a customizable web page for the pharmaceutical company accessible via a global telecommunications network (column 14, lines 6 – 19 and column 7, lines 37 - 42). The hyperlinks allow the user to access a site in which qualified users may submit new entries, thereby making it customizable.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of premium listings hyperlinked to a pharmaceutical company web page and is accessible to the global internet as taught by Ferguson et al. with the motivation of allowing a user to create online services using

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existing information (column 7, lines 1 – 4). Examples of possible existing information include a pharmaceutical medication database and a pharmaceutical company.

As per claim 15, the system of claim 8 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the discount price list is available via a telecommunications network.

Ferguson et al. teaches a system wherein the discount price list and the pharmaceutical listing is accessible via a global telecommunications network (column 14, lines 2 – 6 and column 7, lines 37 - 42). The examiner interprets the discount price list to be a function of the directory look up disclosed by Ferguson et al. It provides information to users of a pharmacy benefit plan.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 14.

As per claim 16, the system of claim 8 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the discount price list is searchable by members of the pharmacy benefit plan.

Ferguson et al. teaches a system wherein the discount price list and the pharmaceutical listing are searchable by the members using one or more search criteria

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(column 10, lines 62-65). Ferguson et al. discloses a method where users are allowed to perform searches, where they can specify the search criteria.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of searching a discount price list and pharmaceutical listings as taught by Ferguson et al. with the motivation of enabling users to search listings or entries in a directory by a variety of techniques (column 14, lines 10 – 12), including names, categories, and full text searches.

As per claim 17, the system of claim 1 is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to explicitly teach a system wherein the advertisements are provided by the pharmacy benefit plan to members.

Ferguson et al. teaches a system comprising one or more advertisements provided by the pharmacy benefit manager to the members (column 14, lines 6 – 12 and column 14, lines 21 – 31). Ferguson et al. discloses a method of online classified advertisements, which are available using hyperlinked documents.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of placing online advertisements as taught by Ferguson et al. with the motivation of increasing the sales of a pharmaceutical company by use of advertisements in the discount price list provided by the pharmacy benefit manager (column 9, lines 54 – 56). An online service can be used as a tool to enable electronic commerce. In this case, the online service would

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advertise a pharmaceutical companies products, which a member could then present to his/her health care provider.

As per claim 18, the system of claim 17 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the advertiser pays the pharmacy benefit manager a fee for advertising.

Ferguson et al. teaches a system wherein an advertiser pays the pharmacy benefit manager an advertising fee to provide the advertisements to the members (column 18, lines 33 – 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of charging a fee to place advertisements as taught by Ferguson et al. with the motivation of creating an easy to use online service (column 10, lines 25 – 29) which can be used to generate revenue for a pharmacy benefit manager by allowing a pharmaceutical company to advertise on pharmaceutical medication lists.

As per claim 19, the system of claim 18 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the advertisement is used to search the pharmaceutical listing.

Ferguson et al. teaches a system wherein the advertisement provided to a member is based on one or more search criteria used to search the pharmaceutical listing (column 14, lines 6 - 12). Searches can be made in directory look up's using names, categories or full text search techniques.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of including advertisements when conducting a search of a pharmaceutical listing as taught by Ferguson et al. with the motivation of introducing a revenue generating tool by charging a fee for the online service (column 14, lines 30 – 31).

5. Claims 21 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée (www.careentree.com) in view of U.S. Patent No. 5,819,092 (Ferguson, et al.).

As per claim 21, the Care Entrée program and Lipton et al. fail to disclose a system in which a computer program is embodied on a computer readable medium, including code segments for receiving membership fees from individuals and providing discount price lists to members, in which the members pay the pharmacy benefit manager directly.

Ferguson et al. teaches a system in which a code segment for receiving a membership fee from one or more individuals to become members of the pharmaceutical benefit program (column 35, lines 24 – 28), and a code segment for providing a discount price list that regulates the cost of pharmaceuticals to members in

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which the members pay the pharmacy benefit manager the discounted price directly (column 31, lines 26 – 31). Ferguson et al. discloses a code segment in which a program defines the fees to be paid to the entity (which in this case is the pharmaceutical benefit manager). Ferguson et al. also discloses a code segment in which a 'yellow pages' style online service is generated. The examiner interprets this to mean that a code segment was used in order to generate a 'yellow pages' style online service.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include code segments to provide a means of receiving membership fees and to provide a discount price list as taught by Ferguson et al. with the motivation of creating an online service to develop a fee structure for membership fees as well as contribute to the generation of a discount price list (column 4, lines 51 – 60).

As per claim 22, the Care Entrée program teaches a system in which individuals pay a membership fee to the pharmacy benefit manager to join the pharmaceutical benefit plan (Page 3, paragraph 10). The Care Entrée program discloses a method in which anyone can pay a certain fee to join a health care plan, or in this case a pharmaceutical benefit plan since a pharmaceutical benefit plan is essentially tied into a health care plan.

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The Care Entrée program fails to disclose an apparatus for providing a pharmaceutical benefit program including a server, storage devices, communication interface, and a membership fee.

Ferguson et al. teaches a system for providing a pharmaceutical benefit program comprising a server (column 7, lines 42 – 47); one or more storage devices communicable coupled to the server, the one or more storage devices containing a discount price list that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager for any pharmaceuticals provided in full directly the discount price (column 7, lines 64 – 66); and a communications interface communicably coupled to the server that allows a member to access the discount price list (column 7, lines 48 – 50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a server, storage devices, and a communication interface as taught by Ferguson et al. with the motivation of creating a computer platform, where the hardware is independent, thus allowing the software to be implemented on several different computer architectures (column 7, lines 33 – 35).

As per claim 23, the Care Entrée program teaches a system of direct point of sale using a network of one or more pharmacies (Page 10, paragraph 53) and one or more customers having access to the network of one or more pharmacies (Page 10, paragraphs 53 - 54).

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The Care Entrée program fails to disclose a variable discount drug price list on a global telecommunication network and a basic or premium drug price listing.

Ferguson et al. teaches a system in which a variable discount drug price list web site on a global telecommunications network that tracks a known standard drug price list that regulates the price of drugs to the customers by the pharmacies and wherein the customer pays the network of pharmacies in-full directly for drugs on the variable discount price list (column 14, lines 13 – 19) and a basic or premium drug price listing on the variable discount drug price list web site wherein the premium drug price listing provides a link to a separate page about the drug (column 14, lines 13 – 19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a variable discount drug price list on a global telecommunication network and a basic or premium drug price listing as taught by Ferguson et al. with the motivation of providing a system in which a user can view a discount, as well as basic or premium, drug price listing via a global telecommunication network (column 7, lines 36 – 42).

As per claim 24, the Care Entrée program fails to disclose a system in which a link to pharmaceutical company and drug is provided from the discount drug price list.

Ferguson et al. teaches a direct point of sale system in which a separate page about the drug is linked to the web site on a global communications network of the drug company (column 14, lines 13 – 19).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system in which a link to pharmaceutical company and drug is provided from the discount drug price list as taught by Ferguson et al. with the motivation of creating a link between the drug, the discount drug price, and the pharmaceutical company on a global communication system (column 10, lines 55 – 58). By creating this link, an association is generated between the various online documents.

As per claim 25 and 26, the Care Entrée program fails to disclose a system in which a link to the drug is an advertisement for the drug.

Ferguson et al. teaches a direct point of sale system wherein the separate page about the drug is defined as an advertisement for that specific drug (column 14, lines 13 – 19 and 21 – 31).

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 24.

As per claim 27, the Care Entrée program fails to disclose a system in which the basic and premium listings include drug name, drug strength, and price.

Ferguson et al. teaches a direct point of sale system wherein the basic and premium listings comprise a drug name, drug strength, and a price (column 7, lines 10 – 18 and column 13, lines 66 – 67 through column 14, lines 1 – 6).

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The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 24.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goch ("A new card deal", Best's Review. Oldwick: July 2002. Vol. 103, Iss. 3; page 73) is cited for relevance for its description of non-insurance health care programs which offer discounted physicians visits and prescription costs. Sawada ("Mainland-based medical plan grows despite state eye", Pacific Business News. Honolulu: June 21, 2002. Vol. 40, Iss. 15; page 23) is cited for relevance for its summary of the Care Entrée program. Babula ("Health care clubs option to insurance", Las Vegas Review – Journal. Las Vegas, Nev.: Nov. 17, 2001. Page 1.B) is cited for relevance in regards to its review of non-insurance health care, including membership fees and discounted rates for physician visits/pharmaceuticals. The following websites have been cited for relevance: www.allianceMD.com, 2001; www.addhealth.com, 2001; and www.procarecard.com, 2001. The previously mentioned websites are non-insurance health plans and provide brief descriptions of the services available.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristine K. Rapillo whose telephone number is 571-270-

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3225. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Akm Ullah can be reached on 571-272-2361. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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